

REMARKS/ARGUMENTS

I. Status of the claims

Claims 9 and 13 are amended, claims 23 and 27 are canceled and claims 34-48 are added. Therefore, claims 9-14, 20-22, 24-28, and 30-48 are pending with entry of this amendment. Support for the amendments can be found in the specification and claims as originally filed. No new matter is added.

II. Subject matter indicated as allowable by the Examiner

The limitations of claim 23 were introduced into claim 9 and the limitations of claim 29 were introduced into claim 13. On page 7 of the office action, the Examiner indicated that no art was cited against claims 23 and 29 and that claims 23 and 29 were rejected only because they were dependent from a rejected claim. Since amended claims 9 and 13 incorporate the limitations of claims 23 and 27, respectively, Applicants respectfully request withdrawal of the rejections of claims 9 and 13 and claims depending from those claims.

II. Rejected subject matter

Claims 9-12, 21, 22, 24, and 25 were rejected under 35 U.S.C. § 102 as allegedly anticipated by Gagnor *et al.* As discussed above, the rejected claims are amended to overcome the rejection, thereby rendering the rejection moot. However, new claim 34 incorporates the subject matter of original claims 9 and 12 and new claim 43 incorporates the subject matter of original claims 13 and 14. Claim 12 was rejected as anticipated in view of Gagnor *et al.* Claim 14 was rejected under 35 U.S.C. § 103 as allegedly obvious in view Gagnor *et al.* in view of Ahern.

A. Rejection of claim 12 in view of Gagnor et al.

According to the office action, claim 12 was anticipated by Gagnor *et al.* With regard to claims 10-12, on page 3 of the office action, the Examiner indicated that Gagnor *et al.* taught:

the composition of claim 9, wherein said target nucleic acid comprises a primer binding site or a probe binding site and said control nucleic acid comprises a sequence that is parallel complementary to the primer binding site or probe binding site of the target nucleic acid (Figure 1, page 5108; page 5110, first paragraph, under "Results", lines 1-10 and page 5112, lines 3-7).

This disclosure does not teach or suggest all of the limitations of original claim 12 (now included in claim 34). Specifically, Gagnor *et al.* does not teach or suggest "primers for the amplification of said target nucleic acid **and** primers for the amplification of said control nucleic acid" as originally recited in claim 12 and now in claim 34. The Examiner appears to argue that oligonucleotide "ps- β -I" in Gagnor *et al.* could be interpreted as a target nucleic acid and "ps- α -II" could be interpreted as a control nucleic acid, or vice versa. Assuming *arguendo* that this is true, Gagnor *et al.* does not teach or suggest inclusion of primers for amplification of each oligonucleotide. Indeed, there is no basis in Gagnor *et al.* at all to amplify both a control and target nucleic acid, where the target and control nucleic acid have a parallel complementary relationship as recited in the claims. Accordingly, Applicants respectfully submit that claim 34, and claims dependent from claim 34, are free of the prior art.

B. Rejection of claim 14 in view of Gagnor *et al.* and Ahern.

Original claim 14 was rejected as allegedly obvious in view of Gagnor *et al.* and Ahern. New claim 43 includes all of the limitations of original claim 14. The Examiner argued, as discussed above, that Gagnor *et al.* described a composition comprising a target and control nucleic acid with at least 8 nucleotides essentially parallel complementary and primer or probe binding sites. Ahern was cited to provide motivation for making the compositions in a kit format.

As described above, Gagnor *et al.* does not in fact teach primers for amplification of the target nucleic acid and primers for amplification of the control nucleic acid. The Ahern reference does not correct this deficiency. Accordingly, the cited art does not teach all of the elements of claim 43. Applicants therefore contend that claim 43, and claims dependent thereon, are free of the cited art.

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Amdt. dated December 6, 2004
Reply to Office Action of July 30, 2004

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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